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| 09/880,045 | 06/14/2001 | Kyoko Kimpara | Q64919 | 5944 |

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SUGHRUE, MION, ZINN, MACPEAK & SEAS
2100 Pennsylvania Avenue, N.W.
Washington, DC 20037-3202

EXAMINER

BORISSOV, IGOR N

ART UNIT PAPER NUMBER

3628

| SHORTENED STATUTORY PERIOD OF RESPONSE | MAIL DATE | DELIVERY MODE |
|--|------------|---------------|
| 3 MONTHS | 01/18/2007 | PAPER |

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary

Application No.

09/880,045

Applicant(s)

KIMPARA ET AL.

Examiner

Igor N. Borissov

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 28 September 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 3-7 and 9 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 3-7 and 9 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____.
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- ☐ Notice of Informal Patent Application
- ☐ Other: _____.

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DETAILED ACTION

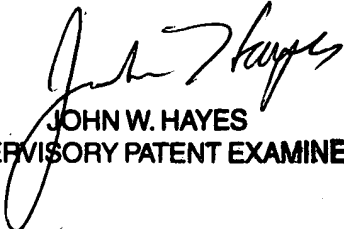
In view of the Pre-Brief Conference request filed on 09/28/06, PROSECUTION IS
HEREBY REOPENED.

To avoid abandonment of the application, appellant must exercise one of the
following two options:

(1) file a reply under 37 CFR 1.111 (if this Office action is non-final) or a reply
under 37 CFR 1.113 (if this Office action is final); or,

(2) initiate a new appeal by filing a notice of appeal under 37 CFR 41.31 followed
by an appeal brief under 37 CFR 41.37. The previously paid notice of appeal fee and
appeal brief fee can be applied to the new appeal. If, however, the appeal fees set forth
in 37 CFR 41.20 have been increased since they were previously paid, then appellant
must pay the difference between the increased fees and the amount previously paid.

A Supervisory Patent Examiner (SPE) has approved of reopening prosecution by
signing below:


JOHN W. HAYES
SUPERVISORY PATENT EXAMINER

Response to Amendment

Amendment received on 09/28/06 is acknowledged and entered. Claims 1, 2, and 8 have been canceled. Claim 9 has been amended. Claims 3-7 and 9 are currently pending in the application.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 3-7 and 9 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Specifically, claims 3-7 and 9 include the following limitation which was not described in the specification: “a non-programmed” conversion instructing banner”.

The specification does not include the term “non-programmed”. Page 17 of the specification defines the conversion instructing banner as following:

“the translation implementing request information I60 is transmitted to the translation server 70 by clicking the translation instructing banner 61 *which is a specifying image area, icon or a like on a monitor screen* linked to a translation instructing program (Step S6, translation request processing).”

There is not indication in the specification that said banner is not a programmed object, a command, a programmed sequence of instructions or Java applet.

Furthermore, the specification states that said banner is an icon or an equivalent of the

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icon. Furthermore, it is well-known in the art that icons represent application programs.

For example, Franco et al. (US 6,687,745 B1) teaches that:

"each application program available on a computer may be represented as an "icon" on the desktop, and each application program running on the computer may be represented as one or more electronic "sheets" displayed in regions of the monitor referred to as "windows" (C. 1, L. 49-56).

Moreover, Segan et al. (US 7,054,928 B2) discloses character icons:

"To perform a function ..., a user will simply select a particular enhancement icon ... whereupon the application or program associated with the selected enhancement icon will be executed to perform the corresponding icon function" (C. 5, L. 12-17).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 3-7 and 9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Furst (US 6,297,819) in view of Yates et al. (US 6,330,586).

Claims 3, 6 and 9.

Furst teaches a system, method and a computer-readable medium containing instructions for translating a Web-page from its native language into a desired language, said system comprising a contents server; a user terminal; and a conversion server, said method comprising:

contents providing processing in which said contents provider terminal provides said contents server with contents (Fig. 1, item 140; C. 5, L. 29) in which a non-

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programmed translation instructing banner (Fig. 1, item 116; C. 4, L. 40-41) including conversion implementing request information is arranged (C. 11, L. 65-67);

contents provider information registering processing in which said contents provider terminal (database server 149; Fig. 1; C. 6, L. 52-55) provides said conversion server (Fig. 1; item 130) with contents provider information including contents information and subscription-related information (subscription window, C. 10, L. 26-28) such that said contents provider information is registered on said conversion server (C. 6, L. 54 - C. 7, L. 7);

contents storing processing in which said contents server stores said contents provided by a contents provider (C. 11, L. 65-68);

contents transmitting processing in which said contents server transmits said stored contents to said conversion server by request of said conversion server (C. 11, L. 65 - C. 12, L. 3);

contents displaying processing in which said user terminal selects and displays said contents stored in said contents server (web browser which displays information from data base server 140, C. 5, L. 29; C. 11, L. 65-68, Fig. 1, item 112);

conversion request processing (translation application, C. 11, L. 65-68), in which said user terminal transmits conversion implementing request information used to make a request of said conversion server for the displayed contents in accordance with an instruction (subscription window) through said translation instructing banner (C. 10, L. 26-28);

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converting processing in which said conversion server (Fig. 1; item 130) refers to said contents registered database (Fig. 1; item 140; C. 5, L. 29), and then acquires said contents from said contents server and converts the acquired contents (translation application, C. 11, L. 65-68) based on said conversion implementing request information received from said user terminal, and registers information that said conversion has been performed as use history information on a storing device (C. 7, L. 6);

conversion result transmitting processing in which said conversion server transmits said results of conversion of said contents to said user terminal (C. 11, L. 65-68);

conversion result displaying processing in which said user terminal inputs results of conversion of said contents from said conversion server and displays the input results of conversion of said contents (C. 11, L. 65-68);

subscription-related information transmitting processing in which said conversion server produces subscription-related information based on the registered contents provider information stored in said contents registered database and transmits said subscription-related information produced to said contents provider terminal (subscription window, C. 10, L. 26-28; Fig. 1, item 140);

subscription-related information inputting processing (subscription window, C. 10, L. 26-28; Fig. 1, item 130);

subscription-related information processing (C. 10, L. 26-28).

Furthermore, Furst teaches producing conversion information based on the registered contents provider information (C. 10, L. 26-28; Fig. 1, item 140); collecting a

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history of preceding simplified or actual URLs requests (C. 7, L. 6), and providing services on a subscription bases (subscription window) (C. 10, L. 26-28), thereby suggesting charging customers for services rendered.

However, Furst does not specifically teach charging conversion fee based on both the registered contents provider information stored in said contents registered database and use history information registered.

Yates et al. teach a system and method for service provision by means of communications networks, wherein usage history and associated accrued charges for services rendered are monitored (C. 19, L. 49-53).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Furst to include charging fee for services rendered, as disclosed in Yates et al., because it would advantageously allow the business to collect revenue. And it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Furst in view of Yates et al. to include that said conversion fee based on both the registered contents provider information stored in said contents registered database (services rendered) and registered usage history, as disclosed in Yates et al, because it would advantageously allow to provide discounts for said subscriptions to the most frequent users thereby stimulating the users to increase their usage time and profits to the system owners.

Claim 4. See reasoning applied to Claims 3 and 6.

Claims 5 and 7. Furst teaches, that in said conversion, said contents, when being described in a foreign language, are translated into contents described in a native language of a user (C. 11, L. 65-68).

Response to Arguments

Applicant's arguments filed 09/28/06 have been fully considered but they are not persuasive.

In response to applicant's argument that Furst does not disclose or suggest a "translation instructing banner including conversion implementing request information," it is noted that Furst does, in fact, teach said feature. Specifically, Furst teaches contents providing processing in which a non-programmed translation instructing banner (Fig. 1, item 116; C. 4, L. 40-41) including conversion implementing request information is arranged (C. 11, L. 65-67).

In response to applicant's argument that Furst does not disclose or suggest that a "conversion implementing request" included in the banner is transmitted to a server (web site), it is noted that Furst explicitly teaches:

"A translation application tool translates a web page from its native language into a default language or a language of the user's choice. The tool transmits the context web page (or a link to the context web page) to a translation server, which produces a results web page that is sent to a client tool window for display." (C. 11, L. 65 - C. 12, L. 3).

In response to applicant's argument that Furst does not disclose or suggest a charging system or conversion fees, it is noted that Yates was applied for this feature. Specifically, Yates et al. teach providing services by means of communications

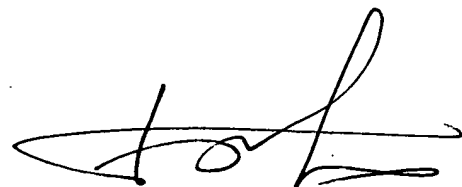
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networks, wherein usage history and associated accrued charges for services rendered are monitored (C. 19, L. 49-53). The motivation to combine references would be collecting revenue, as well as providing discounts for said subscriptions to the most frequent users thereby stimulating the users to increase their usage time and profits to the system owners.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Igor Borissov whose telephone number is 571-272-6801. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John W. Hayes can be reached on 571-272-6708. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



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IGOR N. BORISSOV
PRIMARY EXAMINER